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FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20006

EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1615

DATE MAILED: 01/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,480

Applicant(s)

CANNELL ET AL.

Examiner

Lakshmi S Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-160 is/are pending in the application.
- 4a) Of the above claim(s) 1-120 and 152-155 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 121-151 and 156-160 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Receipt of amendment A, dated 10-23-02 is acknowledged.

The following rejection is maintained for reasons of record:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 151 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for heat activating the hair or keratin fibers, does not reasonably provide enablement for a heat-activated composition. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Instant specification states that one of the embodiments of the instant invention is heat-activated composition (page 4, lines 20-21 and page 5, lines 16-17). With respect to “heat activated” composition, application describes a composition, which shapes at least one keratinous fiber better than the same composition, which is not heated **during or after application of the composition** (page 7, lines 17-21). However, instant specification does not provide any guidance or description as to heating the composition at elevated temperatures, **during or after the application of the composition**. Instead, the only method of heat activating described on page 7, lines 6-16 is, the use of elevated temperatures (above 100 degrees C) provided either by directly contacting one keratinous hair fiber with a heat source i.e., heat

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styling by flat ironing methods, curling, or indirectly providing a heat source i.e., blow dryers, hood dryers, heating caps or steamers. Furthermore, on page 19 (lines 11-21), the example for treating and measuring the Curl Droop also teaches ironing hair (i.e., heat activating hair), but not heating the composition. Thus, applicants only described heat-activated hair. Applicants have not described or suggested any thing in the instant specification that enables one of an ordinary skill in the art to “heat or heat-activate” the composition, what range of temperatures used to heat or the duration of heat activating etc. Absent any guidance as to how to heat-activate the composition, one of an ordinary skill in the art would have to perform undue experimentation prepare a heat-activated composition, as claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 121, 135, 137, 138, 140, 141 and 148-150 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,660,838 to Koga et al (Hereafter Koga, submitted on PTO-1449).

Koga discloses external use preparations comprising xylobiose, in amount of 0.0001 to 20%, preferably 0.1 to 10%. Example 7 (col. 10) of Koga is specifically directed to a hair shampoo, with 8.9% xylobiose. Koga discloses the composition in the form of a cream, lotion, ointment etc (col. 10, claim 3) and also discloses addition of cosmetic additives such as

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polyethylene glycol monostearate (example 7 and col. 2-3), which reads on the claimed additive (claim 150).

Koga fails to disclose the intended use of the instant claims. However, as explained above recitation of intended use of a composition carries no patentable weight. Further, Koga discloses the claimed amounts of xylobiose in the hair compositions and accordingly the ability to impart the claimed effect is inherent to Koga. Therefore, Koga anticipates the instant claims.

3. Claims 121, 130, 131, 133 and 140-150 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,514,367 to Lentini et al (Hereafter Lentini).

Lentini discloses skin cosmetic compositions comprising dihydroxyacetone (DHA) as an active component and cyclodextrin, in the form of creams, lotions, gels etc (abstract, col. 3, lines 46-62). Lentini discloses that the most preferred amount DHA is range of 5 to 10 percent (col. 4, lines 28-36). Further, example 1, Lentini discloses 5%DHA, which is within the claimed amount. Further, Lentini discloses the claimed amounts of DHA and accordingly the ability to impart the claimed effect is inherent to Lentini. Lentini also discloses addition of various cosmetic additives such as penetration enhancers, sugars, emulsifiers (lines bridging col. 3-4). Further, Lentini also other sugars such as sucrose, fructose, glucose (examples 1-4), which read on the instant claims 142-147.

Lentini fails to disclose the intended use of the instant claims. However, as explained above recitation of intended use of a composition carries no patentable weight. Therefore, Lentini anticipates the instant claims.

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3. Claims 121-124, 135, 139-141 and 148-150 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/24009 (WO '009).

WO '009 discloses a hair composition comprising xylose and its fatty acid esters. The latter read on the derivatives of instant claim 139 (abstract). Example 6 of WO '009 discloses 0.3 g of xylose, which is within the claimed percentage in a mascara composition, which also contains pigments and other excipients.

WO '009 fails to disclose the intended use of the instant claims. However, as explained above recitation of intended use of a composition carries no patentable weight. Therefore, WO '009 anticipates the instant claims. Further, WO '009 discloses the claimed amounts of xylose and accordingly the ability to impart the claimed effect is inherent to WO '009.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 151 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,660,838 to Koga et al (Koga).

Koga teaches external use preparations containing xylobiose, in amount of 0.0001 to 20%, preferably 0.1 to 10% (also refer to 102 (b) rejection above). Example 7 (col. 10) of Koga is specifically directed to a hair shampoo, with 8.9% xylobiose. Koga teaches the

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composition in the form of a cream, lotion, ointment etc (col. 10, claim 3). Further, Koga suggests using the composition in the form of hair care products such as hair-treatments, rinses, shampoos and conditioners (col. 2, lines 20-26).

Koga fails to teach the claimed “heat-activated” composition. Please refer to the rejection (item # 3) under 35 USC 112, 1st paragraph. However, Koga suggests using the composition for hair treatments. Although Koga does not specifically suggest treating hair with hair driers or blowers or steamers as described in the instant specification, the “hair treatments” of Koga include all known methods of hair styling, coloring, and shaping, with and without heat activation of hair. Accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to apply the xylobiose-containing composition of Koga, during the process of hair treatment (with or without heat activation) because Koga suggests applying sugar containing compositions to hair and drying, suggests that the compositions impart stability, retain moisture, impart luster and impart natural oiliness to the hair. The expected result would be to impart natural oiliness, moisture and shine of hair.

5. Claim 121,135 and 136 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 08217656 (hereafter JP ‘656, submitted on PTO-1449).

JP teaches cosmetic compositions containing sugar-bound polyaminoacids such as polyornithine, polylysine etc., and the sugars being xylose, arabinose, glucose, fructose etc. JP ‘656 teaches the compositions for hair conditioning and moisture holding. The sugars xylose and arabinose of JP ‘656 read on the pentoses monosaccharides of the instant claims. Further, the polyaminoacids bound sugar reads on the derivatives of sugars. Accordingly, it would have been

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obvious for one of an ordinary skill in the art at the time of the instant invention to choose a xylose or arabinose sugar to which is attached a derivative such as polylysine or polyglutamic acid in a hair composition because JP '656 teaches that the sugar-bound polyamino acids are useful for hair conditioning. One of an ordinary skill in the art would have expected equal hair conditioning and moisture holding with the different polyamino acid bound sugars of JP '656, including monosaccharides such as xylose, arabinose.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 121-151 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 09/614,118. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are anticipated by the copending claims. Instant claims are drawn to a composition containing C3 to C5 monosaccharides, whereas copending claims are drawn to method of protecting hair using a composition

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containing C3 to C5 monosaccharides. The monosaccharides and their amounts claimed in the copending application are same as that of the instant. Instant claims recite the intended use of the composition, “for durable non-permanent shaping of hair”. While copending claims do not recite the intended use of the instant claims, the composition being the same in both sets of claims, the instant intended effect is inherent to the composition of the copending claims. Accordingly, the instant composition is anticipated by the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 121-151 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-199 of copending Application No. 09/820,812. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are anticipated by the copending claims. Instant claims are drawn to a composition containing C3 to C5 monosaccharides, and claim 139 specifically states substituted monosaccharides. Copending claims are drawn to a composition containing C1 to C22 substituted C3 to C5 monosaccharides, and method of protecting hair using the same. The monosaccharides and their amounts claimed in the copending application are same as that of the instant. Instant claims recite the intended use of the composition, “for durable non-permanent shaping of hair”. While copending claims do not recite the intended use of the instant claims, the composition being the same in both sets of claims, the

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instant intended effect is inherent to the composition of the copending claims. Accordingly, the instant composition is anticipated by the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed 10-23-02 have been fully considered but they are not persuasive.

35 USC 112, Enablement Rejection:

Applicants argue that in the instant application the hair fibers are not activated and instead the composition is heat activated and the hair fibers are heated. Further, applicants argue that nothing is activated in the instant application without the instant composition, because the hair is treated with the composition and then heated (causing heat activation of the composition). For the same reasons, examiner still maintains the enablement rejection because as applicants themselves admit the only method of heat activating the composition that is enabled by the instant invention is during or after applying the composition to the hair fibers and not at any other time. Therefore, the rejection has been maintained.

Rejections-35 USC 102:

KOGA or LENTINI or WO '009:

Applicants argue that none of the references anticipate instant claims because of the instant amendment "said composition is heat-activated", which is not taught by any of the above references cited. However, applicants' arguments are not persuasive because the claimed

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heat-activation is relative. Applicants explained in response to enablement rejection that the composition is activated during or after application to hair and also explained (in response to rejection as being indefinite) that the durability refers to shampooing or treatment with water (page 7, lines 1-6 of the response). Examiner notes that Koga also teaches shampoo compositions containing the claimed monosaccharides. In other words, the composition of Koga is heat activated, as claimed. Furthermore, the claim limitation “heat-activated” is an intended use and hence does not carry patentable distinction.

Rejections-35 USC 103:

Koga or JP ‘656:

Applicants argue that does not teach or suggest heat activated composition for the claimed use and Koga only teaches hair treatments without any particular suggestions to modify to suit the claimed use. However, as explained above “heat-activated” does not restrict the claimed composition to any particular temperature and the “heat” is relative and can include any temperature. Koga teaches shampoo composition comprising the claimed composition. It would have been obvious for one of an ordinary skill in the art to wash the hair with warm or hot water after shampooing so as to remove the shampoo from hair and such process involves activating the composition.

Applicants argue that JP does not teach or suggest heat-activated composition for the claimed use. As explained the claimed “heat-activation” is not restricted to one temperature and the claimed non-permanent shaping is an intended use. JP ‘656 teaches the composition for hair conditioning and accordingly it would have been obvious for a skilled artisan at the time of the

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instant invention to use the composition for conditioning the hair with an expectation to retain the moisture of the hair and thus condition hair.

Double patenting rejection:

Applicants requested that the double patenting rejection be held in abeyance until allowable subject matter is identified in the application. Examiner maintains the rejection.

The following is a new rejection (in view of the amendment):

Claims 121-151 and 156-160 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beck (previous action) in view of DE 4440315 or JP07258041 (both DE and JP submitted on PTO-1449).

Beck teaches hair treatment composition comprising a compound chosen from a sugar, a carbohydrate etc., including the claimed glyceraldehydes, DHA, tetroses etc (refer to previous action). Beck does not teach the claimed heat-activation or the claimed use.

DE teaches keratin treating composition-containing carbohydrates such as mono or oligosaccharide, for including in shampoos, hair styling gels, permanent wave lotions etc (abstract).

JP teaches glucose, galactose or xylose containing hemi-cellulose for including in hair cosmetic due to their high set-retaining power.

Therefore it would have been obvious for a skilled artisan at the time of the instant invention to use the carbohydrates such as DHA, glyceraldehydes, tetroses etc., for retaining the hair shape or style because JP teaches that the saccharides have a good set retaining power and DE teach that the compounds protect hair from splitting. With respect to the claimed

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temperatures (in the new claims), the above references do not specifically mention the conditions of hair treatment. However, optimizing the conditions of hair waving and hair styling without adversely affecting the hair would have been obvious for a skilled artisan and the hair styling of DE includes both heat and non-heat conditions. Further, heating the composition during the art recognized styling methods would have been obvious to one of an ordinary skill in the art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S Channavajjala whose telephone number is 703-308-2438. The examiner can normally be reached on 7.30 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7924 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Lakshmi S Channavajjala
Examiner
Art Unit 1615

January 6, 2003

THURMAN K. PAGE
SUPERVISOR, PATENT EXAMINER
TECHNOLOGY CENTER 1600